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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/334,978 | 06/17/1999 | JOHN C. WEBBER | 1365-021C | 5936 |

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/334,978 | WEBBER ET AL. | |
| | Examiner | Art Unit | |
| | Natalie A. Pass | 3626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 July 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

# Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 08 July 2002. The specification has been amended to claim the benefit of U.S. Patent Applications Nos. 08/971, 764 and 08/337, 097. Claims 1-26 remain pending. Claims 1, 2, 5-9, 11, 13, 18-22, and 24 have been amended.

### *Oath/Declaration*

2. The objection to the oath or declaration under 37 CFR 1.67(a) is hereby withdrawn due to the change in the specification in the amendment filed 08 July 2002.

### *Drawings*

3. The objection to the drawings under 37 CFR 1.83 and 37 CFR 1.84 is hereby withdrawn due to the change in the specification in the amendment filed 08 July 2002.

### *Double Patenting*

4. The nonstatutory double patenting rejection under the judicially created doctrine of obviousness-type double patenting is hereby withdrawn due to the terminal disclaimer filed with the amendment filed 08 July 2002.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3, 4, 10, 11, 12, 18, 21, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent Number 5, 715, 448 in view of Shavit et al., U.S. Patent Number 4, 799, 156, for substantially the same reasons given in the previous Office Action (paper number 4). Further reasons appear below.

(A) Claims 1, 11, 18, and 21 have been amended to include the recitation of "network connectivity" and "network connection" as a replacement for the words "connectivity" and "connection" throughout these claims.

As per these limitations, regarding claims 1, 11, 18, and 21, Suzuki teaches an electronic shopping system, comprising a first connection between a first merchant computer (Suzuki; Figure 1, Item 10 – Apparel Manufacturer A) and a network host computer (Suzuki; Figure 1, Item 52, column 4, lines 22-23), said first connection for transmitting product information (Suzuki; Figure 2, column 3, lines 10-11) to said network host computer in accordance with a first type of connectivity.

Suzuki also teaches a second connection between a second merchant computer (Suzuki; Figure 1, Item 10 – Apparel Manufacturer B) and said network host computer, said second connection for transmitting product information to said network host computer in accordance with a second type of connectivity.

Suzuki further discloses a database at said network host computer (Suzuki; see at least Figure 1, Item 53, column 4, lines 12-16, Figure 4) for storing said product information from said first merchant computer and said second merchant computer.

Suzuki also discloses a first computer program at said network host computer for assimilating or processing said product information (Suzuki; Figure 3, column 5, lines 6-9) and a third connection between said network host computer and a customer computer (Suzuki; Figure 1, Item 20) said third connection for transmitting said assimilated or processed product information to said customer computer (Suzuki; Figure 3, column 5, lines 10-16) and for transmitting real time updates (Suzuki; column 5, lines 31-32, 47-48) to said product information, said real time updates obtained in accordance with said first connection and said second connection.

Suzuki also teaches establishing a connection between a customer computer and a host computer in communication with said database, said customer computer adapted to display information received from said host computer (column 4, lines 22-29, Figure 2), receiving at said host computer a request from said customer computer for product information from said database (column 8, lines 59-64, Figure 9, Item S12), and displaying said assimilated or processed product information at said customer computer (column 9, lines 1-6).

Suzuki discloses a system comprising product information not only from a first and second merchant computer but also from a plurality of merchant computers, a plurality of connections between said plurality of merchant computers and a host computer (Figure 1, Items 10, 30, 40).

Suzuki fails to explicitly disclose these limitations in accordance with different types of network connectivity.

Shavit teaches an electronic shopping system which supports connections in accordance with different types of network connectivity (Shavit; see at least Figure 1, Items 74a-i, Item 79, column 5, lines 39-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the electronic shopping system of Suzuki, to include connections in accordance with different types of network connectivity, as taught by Shavit, with the motivation of providing an interactive business transaction processing system permitting controlled on-line interactive concurrent electronic access to various members of an industry, to freight, financial, and related services, and to operational and commercial information data bases and computing services and to provide a system for interactive on-line electronic communications and processing of business transactions between a plurality of sellers and a plurality of buyers (Shavit; column 2, lines 5-19).

The remainder of claims 1, 11, 18, and 21 are rejected for the same reasons given in the prior Office Action (paper number 4, sections 5-6, pages 4-5), and incorporated herein.

(B) Claims 3, 4, 10, 12, 26 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 4, sections 7-10, pages 5-6), and incorporated herein.

7. Claims 2, 14, 15, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent Number 5, 715, 448 in view of Shavit et al, U.S. Patent Number 4, 799, 156, as applied to claims 1, 11, and 21 above, and further in view of Atcheson, U.S. Patent Number 5, 583, 763.

(A) Claims 2 and 22 have been amended to include the recitation of "network connectivity" and "network connection" as a replacement for the words "connectivity" and "connection" throughout these claims. As per these limitations, the combination of Suzuki and Shavit teaches different types of network connectivity as discussed in the analysis of claims 1, 11, 18, and 21 above.

The remainder of claims 2 and 22 are rejected for the same reasons given in the prior Office Action (paper number 4, sections 11-12, pages 6-7), and incorporated herein.

(B) Claims 14, 15, 23 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 4, sections 11-12, pages 6-7), and incorporated herein.

8. Claims 5-9, 13, 16-17, 19-20, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent Number 5, 715, 448, in view of Shavit et al, U.S. Patent Number 4, 799, 156 as applied to claims 1, 11, 18 and 21 above, and further in view of Wiecha, U.S. Patent Number 5, 870, 717.

(A) Claims 5-9, 13, 19-20 and 24 have been amended to include the recitation of "network connectivity" and "network connection" as a replacement for the words "connectivity" and "connection" throughout these claims. As per these limitations, the combination of Suzuki

and Shavit teaches different types of network connectivity as discussed in the analysis of claims 1, 11, 18, and 21 above.

The remainder of claims 5-8, 20 and 24 are rejected for the same reasons given in the prior Office Action (paper number 4, sections 13-14, pages 7-10), and incorporated herein.

(B) Claims 16, 17, 25 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 4, section 13, pages 7-9), and incorporated herein.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 08 July 2002 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 08 July 2002.

(A) At pages 11-12 of the 08 July 2002 response, Applicant argues that the newly added features in the 08 July 2002 amendment are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 08 July 2002 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective

teachings of Suzuki, Shavit, and/or Atcheson and/or Wiecha, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 4), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to Applicant's argument that the applied reference fails to disclose more than one type of "network connectivity", as recited in the claims as amended 08 July 2002, it is respectfully submitted that Applicant ignores the clear and unmistakable teachings of Shavit with respect to communication links that may be any of a wide variety of network services, such as public telephone networks, public data networks, open virtual lines, private or public network, ISDN, Software Defined Networks, leased datalines, etc., and with the remote communications using any of a variety communications protocols such as System Network Architecture (SNA ), X.25, ASYNCH, BSC, etc. (Shavit; column 5, lines 39-65)

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,

2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

December 18, 2002

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600